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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/463, 705 02/23/00 CORTES

J 146.1335

HM12/0604

EXAMINER

BIERMAN MUSERLIAN AND LUCAS  
600 THIRD AVENUE  
NEW YORK NY 10016

RAO, M

ART UNIT	PAPER NUMBER
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1652

19

DATE MAILED:

06/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>09/463,705</b>	Applicant(s) <b>Cortese et al.</b>
	Examiner <b>Manjunath N. Rao</b>	Art Unit <b>1652</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on May 20, 2001
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

#### Disposition of Claims

- 4)  Claim(s) 2-16 and 20-45 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) \_\_\_\_\_ is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims 2-16 and 20-45 are subject to restriction and/or election requirement.

#### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.
- 12)  The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a)  All b)  Some\* c)  None of:
1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- 15)  Notice of References Cited (PTO-892)      18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      19)  Notice of Informal Patent Application (PTO-152)
- 17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_      20)  Other: \_\_\_\_\_

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**DETAILED ACTION**

1. Claims 2-16 and 20-45 are at issue and are present for examination.
2. The reply filed on 3-20-01 is not fully responsive to the prior Office action because of the following omission(s) or matter(s): In response to the restriction requirement, applicant's election with traverse of group I, claims 2-15, 42 and 43 in paper no. 18 is acknowledged. However, there is no proper response for species election corresponding to the elected restriction group.

The species corresponding to the restricted groups were as follows;

Group I: Polynucleotides 1) eryBII; 2) eryCIII; 3) eryCII; 4) eryAI; 5) eryBIV; 6) eryBV; 7) eryCVI; 8) eryBVI; 9) eryCIV; 10) eryCV; 11) eryBVII and each of their respective polypeptide.

Group II: Polynucleotides 1) eryBII; 2) eryCIII; 3) eryCII; 4) eryBV; 5) eryCVI; 6) eryBVI; 7) eryCIV; 8) eryCV; 9) eryBVII.

Group III: DNA sequences oleG1, oleG2

Group VI: 2,3-reductase, desosaminyltransferase, 3,4-isomerase, 4-reductase, mycarosyltransferase, methyltransferase, 2,3-deshydrtatase, 3,4-deshydrtatase, 3,4-reductase, 3,5-epimerase.

Group VII: modified strain B1192, BIV87, CIV89, BV88.

Applicant was requested to elect a single species corresponding to the elected restriction group. For example if group I was elected, Examiner meant applicants to elect a single species from eleven polynucleotides and the respective polypeptide indicated as group I above.

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Similarly if group VI or VII was elected applicant was requested to elect a single species from the above indicated group VI or VII and so forth. However, applicant's response does not include an election of a single species from among the species belonging to restricted group I. Applicant is advised to elect a single species from among the 11 different species belonging to the restricted group I (see above).

Applicant's reply must include an identification of a single polynucleotide along with the SEQ ID NO for that specific polynucleotide. See 37 CFR 1.111.

Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath Rao whose telephone number is (703) 306-5681. The Examiner can normally be reached on M-F from 6:30 a.m. to 3:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, P.Achutamurthy, can be reached on (703) 308-3804. The fax number for Official Papers to Technology Center 1600 is (703) 305-3014.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Manjunath N. Rao

May 28, 2001

*Rebecca Prouty*  
REBECCA E. PROUTY  
PRIMARY EXAMINER  
GROUP 1800  
*16W*